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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,072	05/08/2001	Jingen Zhang	393042	2831
27128	7590	07/02/2004	EXAMINER	
BLACKWELL SANDERS PEPER MARTIN LLP			HAMLIN, DERRICK G	
720 OLIVE STREET			ART UNIT	
SUITE 2400			PAPER NUMBER	
ST. LOUIS, MO 63101			1751	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,072

Applicant(s)

ZHANG ET AL.

Examiner

Derrick G. Hamlin

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on the election made 4/8/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 31-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20-23 and 25-30 is/are rejected.
- 7) ☒ Claim(s) 19 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/01, 4/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-30 in Paper No. 4/8/2004 is acknowledged. The traversal is on the ground(s) that it wouldn't burden the examiner. This is not found persuasive because the applicant is wrong and it would burden the examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(9) as being anticipated by Herber et al., (US 3,976,585).

Herber discloses functional fluid compositions comprising a major amount of a base stock material which may be an ester of phosphorus and an additive amount of an acid scavenger and corrosion inhibitor which is a monoepoxy substituted cyclohexane such as C1-4 alkyl-3,4-epoxycyclohexane, particularly useful as aircraft hydraulic fluid.

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(abstract) The reference further teaches the epoxide disclosed as Formula I. (col. 2, lines 40-50).

The reference is anticipatory.

Claims 1, 16 and 17 are rejected under 35 U.S.C. 102(9) as being anticipated by Herber et al., (US 3,941,709).

Herber discloses functional fluid compositions comprising a major amount of a base stock material which may be an ester of phosphorus and an additive amount of an acid scavenger and corrosion inhibitor which is a monoepoxy norbornyl carboxylate such as C1-4 alkyl-5,6-epoxynorbornane carboxylate, particularly useful as aircraft hydraulic fluid. (abstract) The reference further teaches the epoxide disclosed as Formula II. (col. 2, lines 40-50).

The reference is anticipatory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-15, 22, 23, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herber et al., (US 3,976,585).

Herber is relied upon for the disclosure cited above.

The reference fails to teach all of the instant examples of Formula I.

Although the reference fails to teach all of the disclosed each example of Formula I, all of the disclosed structures are encompassed by Formula I.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the instant functional fluid as Herber discloses functional fluid compositions comprising a phosphorus ester base stock material and an epoxide of Formula I.

Claims 18, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herber et al., (US 3,941,709).

Herber is relied upon for the disclosure cited above.

The reference fails to teach all of the instant examples of Formula II.

Although the reference fails to teach all of the disclosed each example of Formula II, all of the disclosed structures would be encompassed by Formula II.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to create the instant functional fluid as Herber discloses functional fluid compositions comprising a phosphorus ester base stock material and an epoxide of Formula II.

In view of the forgoing, the above claims have failed to be patentably distinguishable over prior art.

The remaining references listed on form(s) 892 and/or 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Allowable Subject Matter

Claims 19 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reference fails to disclose the specific epoxide acid scavengers and neither reference teaches the phosphorus or silicone containing structures.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick G. Hamlin whose telephone number is (571) 272-1317. The examiner can normally be reached on Monday-Fridays from ~8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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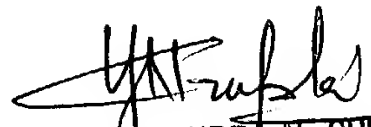
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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick G. Hamlin

6/21/04

DGH


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SUPERVISORY PATENT EXAMINER
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